

REMARKS

Claims 1-53 are currently pending in this application. Certain claims have been amended or cancelled as illustrated by the accompanying set of claims. No new subject matter is believed to have been added by this amendment.

On pages 2-4 of the Office Action, the Examiner objects to a multitude of claims. Each of these claims has been amended to address the Examiner's objections.

On page 4 of the Office Action, The Examiner rejects claims 1-8, 49 and 50 under 35 U.S.C. § 112, second paragraph. The 5th line of claim 1 has been amended to indicate that each outlet offers at least one benefit to the purchaser.

On pages 4 and 5 of the Office Action, The Examiner rejects claims 39 and 40 under 35 U.S.C. § 102 (e) as being anticipated by the teaching of United States Patent No. 5,754, 636 to Walker, et al. (the Walker patent).

The Walker patent is directed to a purchasing system wherein a buyer takes possession at a retailer of a product purchased using a communication network. In particular, a buyer through the services of a purchasing system, purchases a product and is issued a voucher which permits that purchaser to pick up the product at any of a number of different retail outlets. As stated in column 6, lines 5-11, the buyer pays the purchasing system in exchange for the right to take possession of the product at the retailer. As further stated in column 8, line 52-column 9, line 3, a single voucher might indicate that the buyer could take possession of a VCR at either of three local retailers. Furthermore, the voucher may include an offer to purchase a pack of 3 VCR tapes for \$1.00 to the buyer if the buyer takes possession of the VCR at a particular retailer. In the Walker patent, the retailer is the ultimate seller of the product to the purchaser. A purchaser will not visit a retail outlet unless the purchased product is already part of the inventory of the retail outlet. It is the retailer's product, out of the retailer's inventory, which is being purchased and picked up by the customer.

On the other hand, a key feature of the subject invention is to induce a purchaser to visit a retail outlet based upon benefits the retail outlet will provide to the purchaser. As stated in lines 13-15 on page 21 of the application, the outlet may be selected by the purchaser from a list of participating retail outlets. Once the purchaser has selected a retail outlet, the administrator arranges for the purchaser's product to be delivered to that retail outlet and, as a result, the purchaser is known to be coming to the retail outlet. It is at this time that the retail outlet has an opportunity to target market to this individual with a high level of certainty since it is known that this individual will be visiting the retail outlet. This is a fundamental difference from the teaching of the Walker patent. The voucher discussed in the Walker patent may be redeemed at a number of different retail outlets. As a result, no single retail outlet knows that the purchaser will be visiting that outlet and as a result a key element for the opportunity to target market is missing. One very desirable marketing scenarios for a retail outlet is to know a customer will be within the confines of the retail outlet and simultaneously know some of the customer's interests for purchasing. This is an advantage that is neither taught nor suggested by the Walker patent. The Walker patent discloses a method of inducing a purchaser to purchase a specific product in a store which already has the product in its inventory. The subject invention is directed to a method of inducing a purchaser to pickup in a store a product purchased elsewhere in a store, thus giving the store an opportunity to sell other merchandise to a purchaser who would not otherwise be in their store. There is no opportunity to bring in a customer unless he/she is already interested in products in the store because the purchased product must already be in the retail outlet's inventory.

Claim 39 has been amended to specify that an entity must know in advance an individual will be visiting a store. It is at this time that the entity may direct market to the individual before, during or after the store visit. For these reasons, the applicant does not believe that claim 39 as amended is anticipated or suggested by the teaching of the Walker patent or other prior art of record and therefore is patentably distinct over the prior art of record. By way of its dependence upon what is believed to be patentably distinct independent claim 39, dependent claim 40 itself is believed to be patentably distinct.

On pages 6 and 7 of the Office Action, the Examiner rejects claims 1, 2, 3, 4, 6 and 50 under 35 U.S.C. §103(a) as being obvious from the teaching of articles on the PackageNet Website as of April 20, 1999 (the PackageNet article) in view of the article entitled "Microsoft: the Microsoft Plaza Brings Product Returns Convenient to Online Shoppers" (the Microsoft Plaza article). Both of those references relate only to out shipping, from the retail outlet to others. The subject invention, as amended, eliminates all references to the return or outshipping of a product, except at Claim 45. And at claim 45 the retail outlet is informed in advance that the purchaser is coming to the store to send out, or return, the product to an unrelated entity. In the PackageNet model there was no exchange of information or communication, directly or indirectly, between the purchaser and the retail outlet. In PackageNet the retail outlet never knew that the purchaser was coming to the store.

The only reference to the receipt of a package, and its pickup by a purchaser, is in the Galler article cited by the Examiner. There it is disclosed that PackageNet was developing a system for purchasers to pickup a product, however, the purchaser would "pay about a \$3 premium over standard shipping charges." Other than the geographic location and hours of operation of the retail outlet in the PackageNet model, there was no benefit to the purchaser. To the contrary, it was anticipated that the purchaser would pay for the privilege of picking up the package. In addition, there was no exchange of information or communication, directly or indirectly, between the purchaser and the retail outlet, in the PackageNet model.

Combining the PackageNet references, they may describe a service through which a customer may order a product from a supplier and the product may be shipped to the customer utilizing a single commercial carrier. PackageNet acts as an intermediary between the customer and the carrier by providing, for a fee, a number of different retail outlets that are available to receive and hold the customer's order until the order may be picked up at the customer's convenience. Geographical convenience or convenient store hours are the only factors that may influence a purchaser to pick up a product at one location or another. In the PackageNet model, the retail outlet puts forth no effort to induce a purchaser to visit. The subject invention, on the other hand, provides competing benefits from retail outlets to try to induce a purchaser to visit a

retail outlet. There is neither a teaching nor a suggestion in the PackageNet reference that the retail outlet may actively reach out to the purchaser to bring them into their store to pick up a package or, for that matter, to drop one off. The Examiner indicates that under the "price" section of the PackageNet article the shipping costs will be different as a result of a retail outlet located in a different zone. This shipping cost is the cost charged by a shipping company and is completely independent from any benefit provided by the retail outlet, and relates only to the outshipping of packages. Furthermore, the retail outlet had no control over the price of shipping that may be charged to a particular individual.

The PackageNet references do not disclose or suggest reduced cost shipping as a means of inducing a purchaser to visit a store to pickup, or drop off, a package. The PackageNet model offers not a reduced shipping rate, but a different shipping rate. PackageNet compares its out-shipping rates to those of the United States Postal Service and other shippers, and states that PackageNet's are competitive. There is no reduction in rates, PackageNet just states that its outshipping rates are usually the best, and for its in-shipping service that it will charge about \$3 more. There is no reduction in shipping rates based upon marketing factors, but rather simply the calculation of the out-shipping rate using the same variable as would be used for any U.P.S. shipping.

The Microsoft Plaza reference is similar in teaching to the PackageNet reference but introduces the option of returning a package in the same manner by which it was picked up at one of the many retail outlets and therefore, the same arguments applied to the PackageNet article apply here.

Claim 1 has been amended to specify that each retail outlet may provide to the purchaser at least one benefit that is customized based upon information about the purchaser provided prior to the pickup of a product from the retail outlet. This permits the purchaser to select one of the retail outlets for product pickup of a shipped product based upon the customized benefits offered by the retail outlet to that purchaser. This is a fundamental difference from the

teaching of the PackageNet article or the Microsoft Plaza article and the advantages provided are not available though the practices described in these two references.

Therefore, as amended claim 1 is not believed to be obvious from the teaching of the PackageNet article in view of the Microsoft Plaza article or other prior art of record and is therefore believed to be patentably distinct over the prior art of record. By way of their dependence upon what is believed to be patentably distinct independent claim 1, dependent claims 2, 3, 4, 6 and 50 are themselves believed to be patentably distinct over the prior art of record.

Claims 5, 7 and 8 are rejected under 35 U.S.C. § 103(a) as being obvious from the teaching of the PackageNet article and Microsoft Plaza article as discussed on pages 8 and 9 of the Office Action. By way of their dependence upon what is believed to be patentably distinct independent claim 1, claims 5, 7 and 8 are themselves believed to be patentably distinct.

On page 9 of the Office Action, the Examiner rejects claims 49 under 35 U.S.C. § 103(a) as being obvious from the teaching of the PackageNet article and the Microsoft Plaza article and further in view of the teaching of the Walker patent and official notice. First of all, the applicant respectfully disagrees that through the combination of four separate references, the subject matter of claim 49 is obvious. That alone appears to be a strong argument for nonobviousness. Secondly, the PackageNet article is directed entirely to shipping costs for which the retail outlet has no control and which relate to out-shipping of packages, not the pick-up of packages, except for the Galler reference which indicates that a \$3 premium will be charged for in-shipping. The Microsoft Plaza article, on the other hand, is directed to package return and neither discusses nor suggests any monetary benefit provided by the retail outlet. The Walker patent discloses the use of a voucher which lists multiple retail outlets thereby providing to the purchaser the opportunity of visiting any of a number of retail outlets without notifying the retail outlet until arrival of the desire to pick up a product at that outlet. Although the voucher may offer a discount on a related product for visiting the outlet, the product must be in the inventory of the retail outlet. There is no opportunity to bring in a customer unless he/she is

already interested in products in the store because the purchased product must already be in the retail outlet's inventory. The retail outlet in accordance with the Walker patent does not receive a shipped product, but has such a product in its inventory and distributes from inventory when a purchaser comes in with a voucher. For these reasons, the applicant believes that claim 49 as amended is patentably distinct over the teaching of these references and other prior art of record. Additionally, by way of its dependence upon what is believed to be patentably distinct independent claim 1, claim 49 is itself believed to be patentably distinct.

On pages 10-13 of the Office Action, the Examiner rejects claims 1, 2, 6, 8, and 49 under 35 U.S.C. § 103(a) as being obvious from the teaching of the Walker patent in view of official notice and rejects claims 3, 4, 5, 7 and 50 under 35 U.S.C. § 103(a) as being obvious from the teaching of the Walker patent and official notice and further in view of the teaching of the PackageNet article.

As mentioned, claim 1 has been amended to specify that each retail outlet may provide to the purchaser at least one benefit that is customized based upon information about the purchaser provided prior to the pickup of a product from the retail outlet. Claim 1 has also been amended to specify that the product must be shipped pursuant to a purchase by the purchaser. As a result, the outlet is not one that would normally have the product in inventory. In accordance with teaching of the Walker patent, the retail outlet is trolling for customers by placing upon the product voucher a discount coupon the purchaser may use if that purchaser visits the outlet. However, the voucher is related to the purchase of a product already in the store inventory. As a result, the purchaser is provided with benefits to visit a store that he/she would not normally visit in the course of purchasing the product. The PackageNet article, on the other hand, is directed to a system without customized benefits to the purchaser. The only benefits provided by the system disclosed in the PackageNet article is the convenience of a geographical location of out-shipping. Furthermore, neither of these references teaches the intentional customization of benefits to an individual user.

For these reasons, the applicants believe that claim 1 is patentably distinct over the teaching of the Walker patent in view of official notice. Claims 2 through 8, 49 and 50, by way of their dependence upon what is believed to be patentably distinct independent claim 1, are themselves believed to be patentably distinct.

On pages 13 –16 of the Office Action, the Examiner rejects claims 9, 10, 11, 12 and 14 under 35 U.S.C. § 103(a) as being obvious from the teaching of the PackageNet article, the Microsoft Plaza article and official notice and furthermore rejects claims 13, 15 and 16 under 35 U.S.C. § 103(a) as being obvious from the teaching of the PackageNet article and Microsoft Plaza article in view of official notice and further in view of the teaching of the Walker patent

Claim 9 has been amended to specify that each retail outlet may provide to the purchaser at least one benefit that is customized based upon information about the purchaser provided prior to the pickup of a product from the retail outlet. This permits the purchaser to select one of the retail outlets for product pickup of a shipped product based upon the customized benefits offered by the retail outlet to that purchaser.

When related to picking up a package, PackageNet is directed to providing to a purchaser the convenience of picking up a shipped product from any number of different locations however, the purchaser must pay for that convenience and none of these benefits are provided directly by the retail outlet to influence a purchaser to visit their outlet. In particular, there is no customized benefit provided by the retail outlet to the purchaser and this feature is neither taught nor suggest by the PackageNet article or the Walker patent. For that reason, independent claim 9 is believed to be patentably distinct over these references and the other prior art of record and claims 10 through 16 by way of their dependence upon what is believed to be patentably distinct independent claim 9 are themselves believed to be patentably distinct over the prior art of record.

On pages 16-19 of the Office Action, the Examiner rejects claims 9, 10 and 14 under 35 U.S.C. §103 (a) as being obvious from the teaching of the Walker patent and rejects

claims 11, 12, 13, 15 and 16 under 35 U.S.C. § 103(a) as being obvious from the teaching of the Walker patent in view of official notice and furthermore in view of the teaching of the PackageNet article.

As mentioned, Claim 9 has been amended to specify that each retail outlet may provide to the purchaser at least one benefit that is customized based upon information about the purchaser provided prior to the pickup of a product from the retail outlet. This permits the purchaser to select one of the retail outlets for product pickup of a shipped product based upon the customized benefits offered by the retail outlet to that purchaser. Claim 9 has also been amended to specify that the product must be shipped pursuant to a purchase by the purchaser.

The Walker patent, to the contrary, discloses the listing of multiple retail outlets whereby one or more of those retail outlets may provide a discount for a purchaser visiting that outlet to complete the purchase of the product. Each of these outlets already has the product in inventory. Therefore the Walker patent is not directed to a system for inducing a purchaser to visit a retail outlet to pick up a shipped package. On the other hand the PackageNet model is directed primarily to a package out-shipping system, and secondarily to a package delivery and pick up system that neither teaches nor suggests the benefit of marketing to the purchaser. For that reason claim 9 as amended is believed to be patentably distinct over the teaching of the Walker patent and of the PackageNet references and claims 10 through 16, by way of their dependence upon what is believed to be patentably distinct independent claim 9, are themselves believed to be patentably distinct.

On pages 19-22 of the Office Action, the Examiner rejects claims 17, 18, 22 and 25 under 35 U.S.C. § 103 (a) as being obvious from the teaching of the Walker patent in view of official notice and rejects claims 19, 20, 21, 23 and 24 under 35 U.S.C. § 103 (a) as being obvious to the teaching of the Walker patent and official notice and furthermore in view of teaching of the PackageNet article.

Claim 17 has been amended to specify that each retail outlet may provide to the purchaser at least one benefit that is customized based upon information about the purchaser provided prior to the pickup of a product from the retail outlet. This permits the purchaser to select one of the retail outlets for product pickup of a shipped product based upon the customized benefits offered by the retail outlet to that purchaser. Claim 9 has also been amended to specify that the product must be shipped pursuant to a purchase by the purchaser. As previously discussed, these features are neither taught nor suggested by the Walker patent nor by the PackageNet article. For these reasons, claim 17 is believed to be patentably distinct over the teaching of the Walker patent, the PackageNet article and the other prior art of record. By way of their dependence upon what is believed to be patentably distinct independent claim 17, dependent claims 18 through 24 are themselves believed to be patentably distinct over the prior art of record.

On pages 22 through 27 of the Office Action, the Examiner 1) rejects claims 26, 27, 29, 30, and 37 in view of the teaching of the Walker patent, 2) rejects claims 28 and 36 under 35 U.S.C. §103 (a) as being obvious from the teaching of the Walker patent in view of official notice, 3) rejects claims 32, 33, 34 and 35 under 35 U.S.C. § 103(a) as being obvious from the teaching of the Walker patent in view of the PackageNet article, 4) rejects claim 35 under 35 U.S.C. §103(a) as being obvious from the teaching of the Walker patent in view of official notice and 5) rejects claims 38 and 48 under 35 U.S.C. § 103(a) as being obvious from the teaching of the Walker patent in view of official notice.

Claim 26 has been amended to specify that each retail outlet may provide to the purchaser at least one benefit that is customized based upon information about the purchaser provided prior to the pickup of a product from the retail outlet. This permits the purchaser to select one of the retail outlets for product pickup of a shipped product based upon the customized benefits offered by the retail outlet to that purchaser. Claim 26 has also been amended to specify that the product must be shipped pursuant to a purchase by the purchaser. As previously discussed, these features are neither taught nor suggested by the Walker patent nor by the PackageNet article. For these reasons, claim 26 is believed to be patentably distinct over the

teaching of the Walker patent, the PackageNet article and the other prior art of record. Furthermore, by way of their dependence upon what is believed to be patentably distinct independent claim 26, dependent claims 27-38 are themselves believed to be patentably distinct over the prior art of record.

On pages 27 through 31 of the Office Action, the Examiner rejects claims 39 through 44 as being obvious from the teaching of United States Patent No. 5,832,457 to O'Brien, et al. (the O'Brien patent) in view of the teaching of different other references. Claim 39 has been amended to address a product to be shipped pursuant to a purchase by the purchaser and to include the step of knowing in advance an individual will be visiting the store. As a result direct marketing may be directed to the individual before, during or after the store visit to pick up a purchased product shipped to that retail outlet. The O'Brien patent, on the other hand, is directed to a method and apparatus for selective distribution of discount coupons based on prior customer behavior. Such discount coupons are provided immediately after checkout and require the customer to be present in the establishment. In particular, the prior customer behavior referred to in the '457 patent is that behavior associated with a single establishment. As an example, a supermarket may track the purchases of a particular customer and in subsequent visits by that customer, provide coupons directed to the particular needs or interests of that customer based on the prior customer behavior at that supermarket. Furthermore, as described in the abstract, the O'Brien patent is directed to a system for automatically distributing discount coupons or certificates in a retail store conditioned on a pre-selected combination of present and past shopping behavior of a customer whose order is being processed at a checkout stand. The customer is already in the store and is essentially being rewarded to purchase more or to return to the store based upon data generated while the customer was present and shopping in the store. Additionally, the O'Brien patent is not directed to products that are shipped pursuant to a purchase by the purchaser. As amended, claim 39 not only is directed to receiving information prior to the store visit, but furthermore, involves using this information to direct market to the individual before, during or after the store visit to pick up a product shipped to the store pursuant to the product purchase.

The Galler article describes the pickup of a pre-ordered product not discussed in the O'Brien patent. The PackageNet system described in the Galler article merely permits a purchaser, for a fee, to pick up a product from any one of a number of different locations. There is neither taught nor suggested in the O'Brien patent in view of either of these references that the retail outlet knows in advance that an individual will be visiting the store thereby providing the opportunity for direct marketing to the individual before, during or after the store visit to pick up a package shipped to the retail outlet as the result and subsequent to the product purchase by the purchaser. For these reasons, claim 39 is believed to be patentably distinct over the teaching of the O'Brien patent and the Galler article. By way of their dependence upon what is believed to be patentably distinct independent claim 39, dependent claims 40-44 are themselves believed to be patentably distinct over the prior art of record.

On pages 31-33 of the Office Action, the Examiner rejects claims 41-44 as being obvious from the teaching of the Walker patent, in view of the teaching of the PackageNet article and with respect to claims 43 and 44, further in view of official notice.

Based upon their dependence upon what is believed to be patentably distinct independent claim 39, dependent claims 41-44 are themselves believed to be patentably distinct over prior art of record.

On pages 33 and 34 of the Office Action, the Examiner rejects claims 45, 46 and 47 under 35 U.S.C. § 103(a) as being obvious from the teaching of the O'Brien patent in view of the teaching of the Galler article and Garau article. The Garau article simply identifies the fact that target marketing, as a broad concept, existed prior to the subject invention. Claim 45 has been amended to specify that the retail outlet knows in advance that an individual will be visiting the store and, as a result, information may be used to direct market to the individual before, during or after the store visit to pick up a product that was shipped to the retail outlet pursuant to a purchase by the purchaser. Neither the '457 patent nor the Galler article nor the Garau article teach, alone or in combination, the fact that the retail outlet knows in advance an individual will be visiting the store to pick up such a product and for that reason claim 45 is believed to be

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patentably distinct over these references and the other prior art of record. By way of their dependence upon what is believed to be patentably distinct independent claim 45, dependent claims 46 and 47 are themselves believed to be patentably distinct over the prior art of record.

New claim 51 has been added specifying that the reduction in shipping cost is provided by the supplier of the product to be shipped. The support for this claim is found in the applicant's specification on page 22, lines 15-23.

New claim 52 has been added specifying that the at least one benefit provided by the retail outlet to a purchaser is calculated by pre-defined criteria provided in advance by the retail outlet to the administrator. The support for this claim is found in the applicant's specification on page 9, lines 5-19.

New claim 53 has been added specifying that the at least one benefit provided by the retail outlet to a purchaser is determined by a query from the administrator to each retail outlet. The support for this claim is found in the applicant's specification on 9, lines 5-19.

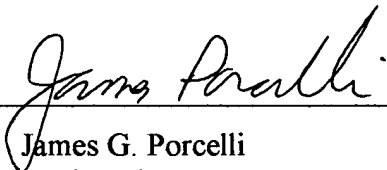
By at least their dependence upon what is believed to be patentably distinct claim 1, dependent claim 51, 52 and 53 are themselves believed to be patentably distinct over the prior art of record.

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Reconsideration of claims 1-50 and allowance of claims 1-53 are hereby requested.

Respectfully submitted,

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